


Appl No.: 10/738,540

Atty. Dkt. UCF-381

REMARKS/ARGUMENTS

Favorable consideration of this application is respectfully requested. Applicant has amended claims 1, 7, 10, 13, 14 and 20, canceled claims 6, 8, 9, 11, 12, 15, and 18 and added new claim 40. No new matter has been added. Claims 23-39 were canceled because they are directed to the non-elected invention. Favorable reconsideration of this application is, consequently, earnestly solicited in view of the following remarks.

OK
Oath or Declaration:

In regard to the oath or declaration, a new Declaration in compliance with 37 CFR 1.67(a) will be submitted as soon as signatures for the four co-inventors are obtained.

Drawing Objection:

In regard to the drawings, Applicant has amended to specification to remove the reference to "8X" mentioned in the description

Specification Objection:

In regard to the specification, Applicant has amended the two paragraphs on page 12, lines 1-5 and lines 9-15 to correct typographical errors to correctly identify the table containing the data described in the paragraph. The paragraph on page 15, line 16, the paragraph on lines 10-22 has been amended to correct the typographical error to correctly identify the head portion with reference numeral 2.

Claim Rejections:

Claims 1-5 were rejected under 35 U.S.C. 102(b) as being anticipated by a French patent to Baron et al. Claim 1 has been amended to include the limitations previously claimed in claims 6, 8, 9 and 12 therefore Applicant believes that amended claim 1 is

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allowable under section 102(b) over Baron. Thus, removal of the section 102 rejection is respectfully requested.

Claims 6-9, 11, 12, 15 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Baron. Applicant respectfully disagrees with the Examiner's allegations.

Baron teaches a protective suit having a head portion as shown in Figs. 2 and 3. The protective suit can be worn by a user that is wearing a breathing mask 7. As shown in Fig. 2, the protective suit includes a hole 5 surrounded by an elastic membrane 4. Located in front of and a distance away from the elastic membrane 4 with the hole 5 is a visor 1 with the large base of the elastic membrane is fixed inside the suit to the perimeter of the visor 1. The user is wearing a separate breathing unit 7 that includes a visor 6 to allow the wearer to see. When the user wears the protective suit, the elastic membrane 4 stretches across the visor 6 of the breathing unit 7 so that there is a space between visor 1 of the protective suit and the visor 6 of the breathing unit 7.

Unlike Baron, original claim 12 claimed an air space comprising a flexible see-through plastic housing having a first end and a second end each end having an elastic-stretchable member which wraps about the face mask and the window portion of the body suit, respectively. Applicant has amended claim 1 to add the limitations of claim 12 and intermediary claims 8 and 9. Claims 8, 9, 11, 12, 15 and 18 have been canceled. Examiner noted that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Baron housing 4 such that the second end possesses an elastic attachment like the first end.

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The mere fact that someone in the art can rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art, without the benefit of the inventor's specification to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

For the obviousness rejection to be proper, the Examiner is required to establish that the reference teaches a suggestion to modify the reference. Baron only teaches a protective suit, not an anti-fogging device for use with a protective suit. The subject matter of claim 12 does not make itself obvious, the teaching or suggestion to modify, has to come from the prior art. There is no teaching, nor suggestion for modifying Baron to include all the novel features of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Baron does not teach or suggest the modification, thus Applicant respectfully requests the removal of the section 103 rejection of claim 12.

Claim 1 has been amended to add the limitation of claim 12 and intermediary claims 6, 8 and 9. For the reasons provided above, Applicant believes that claim 1, as amended, is allowable under section 103 over Baron. Claims 7 and 14 depend from amended claim 1, for the reasons provided in regard to claims 1 and 12, Applicant believes that claims 7 and 14 are allowable and requests removal of the rejection.

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Claims 10, 13, 16, 17, 19, 21 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Baron in view of Spano. In the rejection, Examiner alleges that "it would have been obvious" to combine the teachings of Baron with the Spano invention to produce the subject matter claimed in claims 10, 13, 16, 17, 19, 21 and 22. However, the prior art must provide the teaching or suggestion to combine, Applicant's claims themselves cannot be used to provide the teaching or suggestion. Baron does not teach or suggest the combination with Spano. For the reasons provided in regard to claims 1 and 12, Applicant believes claims 10, 13, 16, 17, 19, 21 and 22 are allowable under section 103 over Baron in view of Spano. Thus, removal of the rejection is requested.

Claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over Baron in view of Spano, and further in view of Garofalo. In the rejection, Examiner alleges that "it would have been obvious" to combine the teachings of Baron with the Spano invention, and then combine the Baron/Spano combination with Garofalo to produce the subject matter claimed in claim 20. The Federal Circuit has stated that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." Baron does not teach or suggest combination with Spano and Garofalo does not teach or suggest combination with Baron and Spano. In fact, the Baron and Spano references were not even cited as relevant art in the examination of Garofalo. For the reasons provided in regard to claims 1 and 12, Applicant believes claim 20 is allowable under section 103 over Baron in view of Spano and Garofalo. Thus, removal of the rejection is requested.

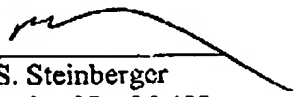
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Applicant has added new claim 40 to claim the combination of subject matter claimed independently in claims 1, 10, 13, 19 and 22. No new matter has been added.

In view of the foregoing considerations, it is respectfully urged that claims 1-5, 7, 10, 13, 14, 16-17, 19-22 and 40 be allowed. Such action is respectfully requested. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney at the below listed number.

Respectfully Submitted;


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Date

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